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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,103	12/27/2004	Atsushi Kurabayashi	040894-7153	2402

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MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER
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LOW, LINDSAY M

ART UNIT	PAPER NUMBER
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3721

MAIL DATE	DELIVERY MODE
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08/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/519,103	<b>Applicant(s)</b> KURABAYASHI, ATSUSHI	
	<b>Examiner</b> Lindsay M. Low	<b>Art Unit</b> 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/31/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on May 31<sup>st</sup>, 2007.

#### ***Information Disclosure Statement***

2. The Information Disclosure Statement (IDS) submitted on May 31<sup>st</sup>, 2007 is acknowledged. The IDS meets the requirements of 37 CFR 1.97 and 1.98. Therefore, the references therein have been considered.

#### ***Drawings***

3. The drawings were received on May 31<sup>st</sup>, 2007. These drawings are accepted.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 4, the phrase "the sheets are bound by the clincher's folding leg portions of the staple" is unclear. It is difficult to discern whether the clincher or the staple has the folding leg portions.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood (1,124,375) for the same reasons set forth in paragraph 11 of the office action mailed March 7<sup>th</sup>, 2007.

8. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood (1,124,375).

It should be noted that the staple injecting port 31 and the recess grooves (between 22 and 23) are connected by the links and connections shown in Fig. 1. Therefore, the grooves are deemed to move integrally with the staple injecting port.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood (1,124,375) in view of Miyake et al (6,219,503).

Wood discloses the same invention substantially as claimed except for a means to switch the press blade lifting means on and off. However, Miyake teaches the use of a switching means for switching ON and OFF the operation of sheet folding (see col. 6 lines 28-44) before stapling. As is well known in the art, an on/off switch is useful in turning ON and OFF a device/mechanism when it is not in use, which allows a user to choose a desired operation and is also beneficial in saving energy. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use an on/off switch with the blade lifting means, in order to allow the operator to turn ON and OFF the folding operation and to save energy when folding is not required.

### ***Response to Arguments***

11. Applicant's arguments filed May 31<sup>st</sup>, 2007 have been fully considered but they are not persuasive.

Applicant contends that the receiving heads and spring clips of Wood cannot form the recess grooves formed at two contiguous portions because the receiving heads and spring clips of Wood are not located on the driver and are not contiguous to the staple injecting port. However, as seen in Fig. 1, the recess grooves (between 22 and 23) are formed at two contiguous portions of the staple injecting port 31. Examiner asserts that claims are given their broadest reasonable interpretation. In this instance, the term "contiguous" does not require the portions forming the grooves to be in contact with the staple injecting port. According to Webster's II New Riverside University Dictionary p. 304, the term "contiguous" can be defined as "nearby or adjacent." The

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recess grooves are nearby and adjacent the staple injecting port of Wood's device.

Nevertheless, the portions forming the recess grooves are connected and therefore are in contact with the staple injecting port as can be seen through the links and connections in Fig. 1.

Applicant's arguments with respect to claim 3 have been considered but are moot in view of the new ground(s) of rejection. It should be noted that the English translation of the Priority document JP 2002-188883 filed with applicant's amendment on May 31<sup>st</sup>, 2007 is new evidence that necessitates a new grounds of rejection.

For the reasons above, the grounds of rejection are deemed proper.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lindsay M. Low whose telephone number is 571-272-1196. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
LML  
8/13/2007

